

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

INLAND DIAMOND PRODUCTS) (
CO.) (CIVIL DOCKET NO.
) (2:17-CV-416-JRG
VS.) (MARSHALL, TEXAS
) (
HOYA OPTICAL LABS OF) (MARCH 26, 2018
AMERICA, INC.) (1:35 P.M.

CLAIM CONSTRUCTION HEARING

BEFORE THE HONORABLE CHIEF JUDGE RODNEY GILSTRAP

UNITED STATES DISTRICT JUDGE

APPEARANCES:

FOR THE PLAINTIFF: (See Attorney Attendance Sheet docketed
in minutes of this hearing.)

FOR THE DEFENDANT: (See Attorney Attendance Sheet docketed
in minutes of this hearing.)

COURT REPORTER: Shelly Holmes, CSR, TCRR
Official Reporter
United States District Court
Eastern District of Texas
Marshall Division
100 E. Houston Street
Marshall, Texas 75670
(903) 923-7464

(Proceedings recorded by mechanical stenography, transcript
produced on a CAT system.)

I N D E X

March 26, 2018

Page

Appearances 1

Hearing 3

Court Reporter's Certificate 64

1 COURT SECURITY OFFICER: All rise.

2 THE COURT: Be seated, please.

3 All right. This is the time set for claim
4 construction in the Inland Diamond Products versus Hoya
5 Optical Labs case. This is Civil Action 2:17-CV-416.

6 Let me call for announcements at this time.

7 What says the Plaintiff, Inland Diamond Products?

8 MS. HENRY: Good afternoon, Your Honor. Claire
9 Henry on behalf of Plaintiff. Along with me today is my
10 co-counsel, John Halan and Mark Jotanovic. We're ready to
11 proceed.

12 THE COURT: All right. Thank you.

13 What's the announcement for Defendant?

14 MR. SMITH: For Defendant, Hoya Optical Products,
15 Your Honor, Michael Smith, and with me today is Mr. James
16 Isbester, Mr. James Sze, and Mr. Kerry Hartman. And we're
17 ready to proceed.

18 THE COURT: All right. Thank you.

19 Counsel, before we get to the disputed terms, my
20 notes indicate that the parties, at least from their
21 submissions as I read them, have agreed for the Court to
22 provide the plain and ordinary meaning with no affirmative
23 need to specifically construe the follow three terms:
24 "ranges from," stemming from Claims 2 and 6 in the '360
25 patent; the term "apex" from Claims 2 and 11 in the '130

1 patent; and "secured to" from Claims 7 and 11 in the '130
2 patent.

3 Is the Court correct in this regard, or is there
4 still some disagreement among the parties?

5 What says the Plaintiff?

6 MS. HENRY: Correct, Your Honor.

7 MR. SMITH: That's correct, Your Honor.

8 THE COURT: Okay. Then the Court will not construe
9 those terms specifically, and we'll move on to the ones that
10 are in actual dispute.

11 We'll start with "interference fit," and let me
12 hear Plaintiff's argument from the podium, please.

13 MR. HALAN: Hello, Your Honor, John Halan, again.

14 THE COURT: Good afternoon.

15 MR. HALAN: Good afternoon to you, too.

16 THE COURT: Please proceed.

17 MR. HALAN: Okay. So this first slide we have
18 here, just as a short brief on the technology at issue,
19 which I'm sure Your Honor already understands, but I wanted
20 to -- and, obviously, it involves an eyeglass frame that
21 encircles a lens, and the lens has a bevel on it.

22 And the main two parts at issue today are that the
23 lens have an interference fit within the frame, which means
24 that at least one dimension of the lens exceed one interior
25 dimension of the frame and that the lens bevel have an angle

1 that is less than the frame grove angle.

2 And I just want to point out one thing with regard
3 to Figure 2 that's off to the right, because I notice from
4 opposing counsel's slide show, that one of their arguments
5 they're going to make is that this doesn't show the frame
6 completely encircling the lens. So that will lead one way
7 from interference fit as we're -- we're presenting it.

8 But Figure 2 is obviously just a -- a cutaway. You
9 can see that the frame has been cut away at the -- not only
10 at the top but also up inside the right side.

11 The patent talks about maintaining lens securely
12 from the frame so it doesn't fall out. That would only
13 happen if the frame encircles the lens.

14 THE COURT: Now, your -- your representation is how
15 I view Figure 2, as well.

16 MR. HALAN: All right. Thank you, Your Honor.

17 THE COURT: It's a cutaway.

18 MR. HALAN: Thank you.

19 Next slide.

20 So this shows -- this is an example claim, but we
21 have our construction, and our construction -- it's really
22 only the green part that we're requesting the Court to use.
23 I mean, the last part of it, opposing counsel point out in
24 their briefing that's -- and the claims are within the
25 specification.

1 But our main definition we're asserting is that
2 an -- interference fit means that the external dimension of
3 the lens exceeds a corresponding internal dimension between
4 the frame channel bottoms.

5 Now, Hoya's asserted construction has changed.
6 Initially it was the top one there, a point of contact at
7 which frictional forces interfere with the motion of the
8 lens. And then after reading our brief and realizing the
9 error of their ways, they -- they changed it, and they went
10 to a different definition.

11 I just want to point out that the language we have
12 highlighted in blue there is basically the same language in
13 both definitions. So they have moved -- they've moved from
14 a point of contact at which into a different contact
15 argument, a bevel fitting into a triangular channel in such
16 a manner that it, again, interferes with motion by
17 frictional forces.

18 The -- the problem with this, again, is it's
19 just -- it's just contact alone. I'm going to get to that
20 in more detail. But, also, Your Honor, they're trying to
21 add limitations contrary to the patent.

22 And if you can go to the next slide.

23 So, for example, they're trying to add a limitation
24 that the channel be triangular. And by the way, Your Honor,
25 this slide and the next slide are not in the printed pub --

1 printouts I gave. I just thought of these this morning, so
2 I apologize, and I can provide printouts to the Court
3 afterwards if you'd like.

4 But -- so they -- they want to assert that
5 interference fit require a triangular channel, when I show
6 on the right-hand side, our patent clearly shows there
7 doesn't have to be a triangular channel. In fact,
8 triangular channel -- the word "triangular" doesn't occur
9 anywhere in -- in the patent.

10 The only thing that can possibly be construed that
11 maybe mean a triangular channel is Dependent Claim 12 of the
12 '360 patent, which is shown here that describes the
13 receiving channel bottom comprising the intersection of the
14 opposed interior wall surfaces which appears to be what
15 would be shown on Figure 3B on the right which would be --
16 would follow through triangular, but it's not a requirement
17 of the claims.

18 And so we have some log on here -- not only do they
19 try to improperly import a limitation from a dependent
20 claim, but as we pointed out in the log on here, this -- the
21 claim construction they're asserting does not encompass a
22 disclosed embodiment, that being the Figure 6 embodiment,
23 and -- and there's warnings that, of course -- of course,
24 you're not going to construe the claims to be limited to one
25 embodiment such as what's shown in Figure 3B.

1 Now, their problem with their construction -- go to
2 the next slide -- is, again, it's just -- all that's
3 occurring, again, is mere contact. This is their
4 construction, and this is a pretty poor drawing. I did it
5 hastily this morning, Your Honor. I'm sorry, I'm not an
6 art -- artist. But if you assume that the yellow is the
7 lens, and, obviously, we have a curvature to it. It
8 wouldn't be two triangulars.

9 THE COURT: I got no problem with your drawing. I
10 wish you had used a larger font, but nonetheless...

11 MR. HALAN: Okay. I'm sorry, Your Honor.

12 THE COURT: I think I can read what you've got
13 here.

14 MR. HALAN: But assuming this is a -- the blue --
15 the blue part is a cross-section of a frame, their
16 construction would cover mere contact. So as long as the
17 bevel fits into a triangular channel in such a manner that
18 the channel interferes with the motion of a lens by
19 frictional force, according to them, that would meet the
20 claim limitation.

21 But if it's only contact -- let's say the example
22 here shown at the bottom of the frame and the top is loose,
23 it wouldn't be secured as required by the patent. And the
24 patent stresses that the interference fit secures a lens
25 within the frame.

1 THE COURT: Let me ask you this, counsel.

2 MR. HALAN: Yes.

3 THE COURT: What's your position on compression?

4 Is it your view that compression is inherent in achieving an
5 interference fit within the scope of the terms -- claims,
6 rather?

7 MR. HALAN: It is our position that an interference
8 fit would result in compression. There are two different
9 terms -- interference fit is the -- is describing the
10 dimensional relationships between the various pieces, while
11 compression is -- is giving the result.

12 And that was actually added during prosecution,
13 Your Honor. One reason it was added during prosecution was
14 to -- to avoid the way the examiner -- the things that the
15 examiner was saying, to make sure it was clear that
16 interference fit, it does result in compression, which is --
17 our -- our view of the point is that compression confirms
18 that interference fit is what we're arguing it does mean.

19 THE COURT: Well, if you take your proposed
20 construction and you drop out the resulting contact and
21 secures the lens and you've told me just to focus on the
22 blue, which is the prior part of the proposed construction,
23 it seems what you're basically saying in layman's terms is
24 the lens is bigger than the frame when they fit together.
25 And so either the frame has got to give, the lens has got to

1 give, or they've both got to deform in some way once they
2 get in a position to achieve this interference fit.

3 MR. HALAN: Well, given the -- to form, the form
4 can -- as we pointed out in our brief, you're -- you're
5 right, Your Honor. We're saying at least one dimension --
6 only one dimension has to be greater than the frame.

7 So, for example, if -- if the vertical dimension of
8 the lens were greater than the frame dimension, but the
9 horizontal dimension was a little bit smaller than the frame
10 dimension, there would be an interference fit, but the frame
11 actually just bends to allow the lens to fit into the frame,
12 but there would be an interference fit. And -- and
13 depend -- and -- and whether it deforms or not, it all
14 depends on, first of all, the extent of the difference in
15 size.

16 THE COURT: So de -- deformation is not a given?

17 MR. HALAN: No, it's not a given, Your Honor.

18 THE COURT: And is compression a given, in your
19 view?

20 MR. HALAN: If there's interference fit, there will
21 be compression --

22 THE COURT: Okay.

23 MR. HALAN: -- yes, Your Honor.

24 THE COURT: Go ahead.

25 MR. HALAN: Okay. And, again, Your Honor, in our

1 original -- with regard to the original construction, one
2 of -- you know, we -- one of our positions we pointed out is
3 that mere contact -- the resistance by frictional forces
4 isn't sufficient because a lens laying on a table, you can
5 push it, and there's -- frictional force is resistant to
6 pushing, that's not a fit -- that doesn't -- that doesn't
7 meet the fit requirement, and it surely does not meet the
8 interference fit -- the interference fit requirement.

9 The same thing, again, which is shown on this
10 drawing, you can -- example, you take the lens out, and if
11 there's a groove on a table, a triangular groove, you can
12 put the lens in that groove, and you can push it, and
13 there'd be frictional forces resisting it, but that would
14 not be a fit and sure wouldn't be an interference fit.
15 There would be nothing -- this doesn't -- but their
16 definition by itself does not secure the lens within the
17 frame.

18 Next slide.

19 So this is some things that were discussed in our
20 brief. Obviously, there's a heavy presumption that a claim
21 terms carries its ordinary and customary meaning.

22 Hoya out -- has out -- out -- outright rejected the
23 ordinary meaning of interference fit as it's understood in
24 the art of eyeglass technology. And, actually, it's a --
25 it's a well understood term in engineering -- all kinds of

1 engineering disciplines, but it's not the kind of term
2 that's understood by a layperson.

3 And the quote there at the bottom is the ordinary
4 meaning of interference fit taken from a dictionary. And,
5 again, the def -- the ordinary meaning of interference fit
6 is that a dimension of one part be larger than the part to
7 which it's being inserted or fitting.

8 So if you go to the next slide.

9 And, again, this is just pointing out that if it is
10 a term that's not understood right -- understood by a
11 layperson, you're allowed to use extrinsic evidence. And in
12 this case -- and it hasn't been disputed at all in this
13 case, all -- all extrinsic evidence points to the same
14 ordinary meaning. And I'm not going to bore Your Honor with
15 the -- all the extrinsic evidence we have in our brief,
16 but -- go to the next slide.

17 We have a number of inter -- industry treatises
18 that we've cited. This is one of them where it talks about
19 the outer -- outer diameter of a ring being oversized -- and
20 figure out the inner dimension of a cell into which it's
21 being asserted -- inserted. That's interference fit. And
22 if you need further explanation of any of these, just let me
23 know, Your Honor.

24 Next slide.

25 This is -- was Hoya's own evidence that they've

1 relied upon. The left side is showing what's called the
2 clearance fit where the dimension of the piece on the right
3 is smaller than the bore or opening into which it's being
4 inserted, while in interference fit, and it's an
5 exaggeration, obviously, but the interference fit on the
6 right side is showing that there has to be a dimension
7 bigger on the shaft -- bigger than the hole into which it's
8 being inserted, again, confirming our definition.

9 Next slide.

10 We cited a number of prior art patents in the
11 optical industry, Your Honor, and they all confirm exactly
12 our definition. And, again, this is evidence of -- of how
13 this term is understood in the -- in the art.

14 THE COURT: I'm not -- I'm not hearing anything
15 about the necessity of a point of connection between the
16 vertex of the bevel and the vertex of the channel or
17 retention structure. What's your view on that?

18 MR. HALAN: Well, the claim -- the claim requires
19 that. The claim requires that between the vertex of the
20 bevel angle and the groove of the channel. I'm not sure --
21 but it also requires in addition to that that there be an
22 interference fit, which requires, again, that one size be
23 bigger than the other size.

24 And the only way that can be achieved is that one
25 dimension -- overall dimension of the lens is larger than

1 one internal dimension of the frame.

2 THE COURT: I'm just trying to get the broader
3 context here.

4 MR. HALAN: Okay. Did I answer your question?

5 THE COURT: I think so.

6 MR. HALAN: Okay. So, again, there are a number of
7 prior art patents. They all confirm our meaning again.
8 Hoya is not pointing to anything to the contrary.

9 And next slide.

10 We had our own expert inventor testimony. He's had
11 more than 47 years of experience in this industry. It's set
12 forth in his declaration. And as he testified, it's clear
13 be -- at the time, before and after that, the term
14 "interference fit" has always had just one meaning in the
15 industry, and that -- that is that one dimension exceed the
16 dimension of the piece into which it's being inserted or
17 assembled.

18 Next slide.

19 There's only two exceptions to ordinary meaning,
20 Your Honor. Both of them require that the patentee take an
21 action. So the first is the patentee sets out a definition
22 of his own, contrary to ordinary meaning.

23 The second is if the patentee disavows the scope of
24 the claim, either in the specification or during
25 prosecution. It not only must be done by the patentee, it

1 must be clear -- must -- the clear -- the alternative
2 definition must be clearly set forth. And not only that,
3 but the intent to change the definition must be clearly
4 expressed.

5 And, again, for disavow the same thing. It
6 requires a clear disavowal. And in the final case we have
7 cited there, absent a clear disavowal or contrary
8 definition, the patentee is entitled to the full scope of
9 his claim language, that being ordinary meaning.

10 Next slide.

11 So Hoya's main argument is they relied on the
12 examiner's statement that was made during prosecution. So
13 in the top there, there's the examiner's statement. And
14 this is taken from Hoya's brief. In the Office Action, the
15 examiner defined the claim language.

16 So it was something the examiner said. It was
17 never adopted by the patentee. It's first our position --
18 in these bullet points down here are our various positions
19 in response to their positions.

20 The first one is our position is the examiner is
21 merely stating his own view of how the Chappell prior art
22 patent bevel interacted with the frame channel. And, by the
23 way, the drawing done on the right side, that's taken from
24 the Chappell patent.

25 And, again, the prosecution history -- as set forth

1 in our second bullet point, the prosecution history cannot
2 be relied upon for disavowal or an alternative definition
3 unless the applicant took the position before the PTO. The
4 applicant never took this position. That was something that
5 the examiner said.

6 And, in fact, as set forth in the next bullet
7 point, Inland specifically rejected that examiner's
8 statement. We said -- it was pointed out the frame groove
9 of Chappell is actually not securing the lens to the frame.
10 As shown on the right-hand side in the Chappell patent, the
11 frame is only a half piece on the top, and there's a wire
12 piece that goes around the -- the perimeter of that and
13 holds the lens in place.

14 So the frame there was not going to hold it in
15 place. There's no interference fit or any kind of fit by
16 the frame itself holding the lens in place. It requires an
17 extra piece, a metal -- yes, Your Honor. It looks like you
18 have a question.

19 THE COURT: Well, I was going to ask you to slow
20 down a little bit. I'm trying to make sure I follow you,
21 and some of what's coming out is rattling out pretty
22 quickly.

23 MR. HALAN: Okay. Okay. Should I back up a little
24 bit?

25 THE COURT: No. I think I'm with you, just if

1 you'll slow down going forward.

2 MR. HALAN: Okay. Well, again, so Inland rejected
3 the examiner's statement. Inland described what's actually
4 being shown by Chappell, and they -- and by saying Chappell
5 does not teach an interference fit.

6 And then the last bullet point, to make it even
7 more clear, in a later Interview Agenda, Inland stated this,
8 quote, one potential amendment could be to add that the
9 vertex is compressed or that it deforms as a result of the
10 interference fit, period, close quote. And that amendment
11 was later made, as pointed out in the briefs.

12 So, again, the compression was an element that was
13 added to -- to further distinguish interference fit from any
14 other kind of fit that the examiner was saying it was.

15 THE COURT: All right.

16 MR. HALAN: And, again, the main thing -- one of
17 the main things here, again, is that the applicant never
18 took that position. It never disavowed. It never
19 redefined.

20 Next slide.

21 And that's all I have on interference fit, Your
22 Honor.

23 THE COURT: All right. Let me hear a response from
24 the Defendant.

25 MR. ISBESTER: Good afternoon, Your Honor. James

1 Isbester on behalf of Hoya.

2 THE COURT: Good afternoon. Go ahead.

3 MR. ISBESTER: I'd like to begin, if I may, with a
4 brief description of -- of Hoya and its business because I
5 think it -- it may be informative to understanding the
6 background of this case.

7 Hoya makes prescription lenses. It starts with
8 blank lenses. And then, for example, if you require a new
9 pair of eyeglasses, Your Honor, you go to your optician.
10 The optician would determine the prescription, confer with
11 you about a frame, select a frame. The optician would
12 acquire the frame, and then send the frame, with the
13 prescription information, to Hoya who would take one of its
14 blank lenses, surface the lens to the prescription
15 appropriate to the patient, edge the lens to fit within the
16 eye frame, mount the lens in the frame, and send it back to
17 the optician.

18 The point of this is that in its first slide,
19 Inland describes to you the various components of the
20 technology here. The frame part of that equation is
21 something that Hoya does not do, and we're not privy to the
22 design of frame information other than what the optician
23 tells us and the mounting procedure that we do.

24 THE COURT: But it's the frame that informs you as
25 to how to prepare the lens so that it fits together as a

1 complete product?

2 MR. ISBESTER: In some -- in some respects, but in
3 others not.

4 THE COURT: All right.

5 MR. ISBESTER: We've got a certain amount of
6 limited data either from the frame or from the optician, and
7 cut the lens to that limited data.

8 It may come up down the road, so I'll simply point
9 out now that among the pieces of information that are not
10 provided and not acquired by Hoya is the shape of the
11 channel into which the lens is placed. All Hoya does is
12 measure the -- the circumference of that channel, and then
13 it cuts a lens to fit into that circumference.

14 THE COURT: You don't actually measure the angle of
15 the channel itself, just the circumference?

16 MR. ISBESTER: Exactly.

17 THE COURT: If you wanted to measure the angle of
18 the channel, I assume you could do that?

19 MR. ISBESTER: Your Honor, this is not on the
20 record anywhere, but we have inquired. There was a machine
21 that was developed in Japan and sold in the United States
22 that would do that. Hoya was never able to get that machine
23 to provide accurate readings and so has never used it
24 commercially. That was several years ago -- I think about
25 five years ago. At the moment, we don't have any way of

1 measuring that angle.

2 THE COURT: Well, and I understand the dictates of
3 commerce might require that you not do certain steps or
4 functions that in a vacuum you might be able to do, but
5 having possession of the frame, I guess you could measure
6 any way you wanted to measure it, even though you might not
7 do that in your practice or it might not be commercially
8 feasible to take intricate measurements in -- internal to
9 the retention channel or -- or the frame.

10 MR. ISBESTER: Presumably, there are people with
11 the right measurement equipment somewhere who -- who could
12 do that.

13 THE COURT: But that's not your client?

14 MR. ISBESTER: But that's not my client's?

15 THE COURT: Okay.

16 MR. ISBESTER: And -- and I agree, Your Honor, that
17 my client could go out and obtain the equipment necessary to
18 do that, but it hasn't done that.

19 THE COURT: All right.

20 MR. ISBESTER: Now, counsel wanted to bring to your
21 attention at the outset of the comments Mr. Halan offered,
22 Figure 2 of the patent.

23 And if I could ask Mr. Hartman to flip to Slide 23.

24 We've colorized Figure 2, the gray for the frame
25 because these frames are described in the patents as -- as

1 metal frames, and the blue for the lens. And --

2 THE COURT: So those are sunglasses?

3 MR. ISBESTER: Yeah. Exactly, Your Honor.

4 And -- and Mr. Halan commented that this is a
5 cutaway, and the other half of the lens is intended to be --
6 is implicit in this drawing.

7 And the implication -- or at least the inference I
8 drew is that this is a case about eye frames in which the
9 frame entirely encircles the lens.

10 And I just wanted to direct the Court's attention
11 to the patent -- Mr. Hartman, if you can bring that up.

12 Top of Column 5 of the patent, for -- further, it
13 should be understood that the bevel may be connected to the
14 vertex and so forth. In addition, it should be
15 understood -- and it goes through a number of different
16 iterations of what this invention can cover.

17 And then finally, it says: For example, the bevel
18 may be present on a portion of the lens body periphery when
19 the lens body is used with eyeglass frames having only
20 framed portions corresponding to the upper half of the lens
21 body. In other words, Your Honor, Figure 2 is the generic
22 instance of the invention of this patent.

23 There is no doubt -- excuse me -- also a specific
24 instance in which the frame entirely encompasses the lens,
25 but that's nowhere shown in the patent.

1 THE COURT: I understand.

2 MR. ISBESTER: One last detail about -- about my
3 client.

4 Hoya is located in Lewisville here in -- in the
5 Eastern District of Texas where it has its head office,
6 450 employees there, and approximately a thousand employees
7 around the country, all of whom are engaged in the same
8 business of surfacing lenses to a prescription and mounting
9 them in the frames.

10 Now, if I can ask Mr. Hartman to flip to Slide 9.

11 Mr. Halan made a comment about the frame
12 triangular. And before we get into the discussion of -- of
13 our reasons why we believe our definition of interference
14 fit is correct, let me just point out one concern I have
15 about Mr. Halan's comments. And, that is, if you look at
16 the definition of the channel, it's defined by -- and after
17 the highlighted terms, which we may not need to address
18 today, the highlighted term "defined by," you see: Opposed
19 interior wall surfaces having a first angle therebetween.

20 So the point, Your Honor, is that when you have
21 opposed interior wall surfaces and they define an angle,
22 that's a triangle. So Mr. Halan's objection to the word
23 "triangle," I don't think, is consistent with the claim
24 as -- as written.

25 Okay. Mr. Hartman, can we go to Slide 14?

1 Now, here you see, Your Honor, the -- the claim
2 language that is in dispute. This is an excerpt from the
3 '360 patent, Claim 1, and the two parties' competing
4 definitions.

5 And the first thing that struck me when I saw this
6 put together was how much longer the Plaintiff's definition
7 is than the Defendant's.

8 This turns patent litigation -- or at least claim
9 construction -- excuse me, Your Honor -- on its head.
10 Ordinarily, the Plaintiff is seeking a broad construction
11 that will apply to lots of different accused products, and
12 the Defendant is trying to avoid infringement by seeking a
13 narrow construction.

14 That's not what's happening in this case, Your
15 Honor. With respect to both "interference fit" and "in
16 compression," the Plaintiff has realized the -- thank you --
17 the effectiveness of their representation at the PTO may
18 have been a little bit too good, and they have obtained
19 claims that are too broad.

20 And now, before you, the Plaintiff is seeking to
21 disavow claim structure by adding claim scope -- excuse me,
22 by adding new structures to the claim. And we will see this
23 repeat both, as I said, in "interference fit" and "in
24 compression."

25 Next slide.

1 THE COURT: Let me ask you this, counsel. In your
2 briefing, you argue that the ordinary and customary meaning
3 of interference fit requires the interference, I think you
4 said, under all tolerance conditions. Can you tell me what
5 you mean by "under all tolerance conditions"?

6 MR. ISBESTER: Yes, Your Honor.

7 Now, perhaps this would have been more appropriate
8 for a jury presentation, but --

9 THE COURT: We may get there.

10 MR. ISBESTER: -- I find it easier to work with
11 something physical.

12 In -- in this instance, this is the prior art. So
13 you have a -- a big wide bevel that's fitting into a
14 triangle -- in a triangular channel. And there are
15 certain -- there's a space at the bottom here. And during
16 prosecution, the Plaintiff -- well, Mr. Wiand, argued that
17 that space was a disadvantage. It meant that the bevel
18 didn't fit as far into the channel as it would have
19 otherwise.

20 The invention was to narrow the bevel. Same
21 channel. Now the bevel fits further down. And you've got a
22 tolerance from the top of the -- of the channel to its
23 bottom that's sufficient to keep the lens from popping out
24 of the frame.

25 So here is, obviously, the optimum situation, but

1 if it's not quite optimum up to the full height of the
2 channel, it's still sufficient to keep the bevel in the
3 channel.

4 And we believe that that's -- indeed, to the extent
5 there is an advantage to this design, that's -- that's
6 probably the primary advantage, not that the bevel is
7 contacting the bottom of the channel but rather that the
8 narrower shape of the bevel ensures a greater range of
9 tolerance -- a greater tolerance and still operate properly.

10 THE COURT: So what you're telling me is that your
11 meaning of "under all tolerance conditions" is as long as
12 the bevel is somewhere inside the channel? Is that what
13 you're saying? I'm not sure I'm following you.

14 MR. ISBESTER: Well, our -- our construction
15 doesn't specifically require under all tolerance conditions.

16 THE COURT: But I thought you argued for that in
17 your briefing. It didn't make it to your construction,
18 but it -- but --

19 MR. ISBESTER: I apologize, Your Honor, if that
20 appeared to be what we were requesting in our --

21 THE COURT: Okay.

22 MR. ISBESTER: -- in our briefing. It was not our
23 intent.

24 THE COURT: Then we'll move on.

25 Are you telling me that unlike many typical

1 situations where the Plaintiff wants a broad construction
2 and the Defendant wants a narrow one to avoid infringement,
3 that the Plaintiff wants a narrow one here to avoid
4 invalidating prior art, or what's your rationale as to why
5 this is not the typical situation?

6 MR. ISBESTER: We believe that's what -- exactly
7 what's going on, Your Honor.

8 THE COURT: Okay.

9 MR. ISBESTER: I -- I realize that's putting the
10 cart before the horse, but I think that's where we end up.

11 THE COURT: All right. Continue with your
12 argument, please.

13 MR. ISBESTER: Mr. Halan addressed at some length
14 the extrinsic evidence of the plain and ordinary meaning of
15 interference fit. And that extrinsic evidence is what
16 informs in what I would respectfully suggest is a
17 cherry-picking fashion, the definition that the Plaintiff
18 has provided.

19 I'm sorry, where -- can we go to Slide 15? Yeah,
20 okay.

21 And that definition is incorrect, we believe, for
22 four separate reasons.

23 The first is that it incorporates into the claim
24 limitations that are found not in the specification even but
25 in the extrinsic evidence.

1 And as Your Honor knows, extrinsic evidence is
2 disfavored. As the Court in Phillips pointed out, there's
3 often so much extrinsic evidence, often contradictory, that
4 one can form just about any definition one wants if one is
5 permitted to use the extrinsic evidence.

6 But what we would like to do here is show you why
7 it doesn't work for perhaps the clearest legal reason, that
8 it conflicts with what's taught by the specification.

9 Next slide.

10 The Plaintiff went through a variety of sources,
11 treatises, dict -- dictionaries, and so forth from which
12 they selected discrete components of a -- of a definition.
13 And so you see a fit in which one part is -- slightly
14 exceeds the internal dimension of the part into which it has
15 to fit or one is larger than the other. That's the -- the
16 theme throughout. Every time their definition of
17 interference fit requires that a bigger thing be squeezed
18 into a smaller thing, into a smaller space.

19 And in case one missed the point, at Page 14 of the
20 brief, Plaintiff demonstrates the difference between or
21 illustrates the difference between a clearance fit and an
22 interference fit. And here you have a shaft of a particular
23 diameter fitting into a hole of a particular diameter. And
24 the shaft, although not terribly illegible in this drawing,
25 is a little bit smaller than the hole into which it is

1 supposed to fit. That's a clearance fit. Seems pretty
2 straightforward.

3 And then you have the opposite, an interference
4 fit. And here you have a hole and a shaft that is much
5 bigger than the diameter of the hole, and the shaft has to
6 be forced into that hole.

7 So is that what the patent describes? Absolutely
8 not. Remember, this is the prior art.

9 If we can go to the next slide.

10 Figure 3 -- 3A is the prior art where you have a
11 wider bevel being forced into a narrower channel.

12 Figure 3B, where you have a narrow bevel and a
13 wider channel, is the invention.

14 So the definition that Plaintiff now offers turns
15 what's taught by the patent on its head.

16 THE COURT: Well, I understand the Plaintiff to be
17 arguing that the larger component to fit in the smaller
18 component is the lens to fit in the frame. It seems like
19 what you're telling me is this relates to the -- the bevel
20 and the retention channel as -- as opposed to
21 larger/smaller.

22 MR. ISBESTER: Exactly. And --

23 THE COURT: So is it -- is it the bevel and the
24 channel, or is it the lens and the frame? What are we
25 comparing to determine if something is larger or smaller

1 than the other?

2 MR. ISBESTER: I am not a mechanical engineer, and
3 I don't have Mr. Wiand's 47 years of experience. All I'm
4 left with is the claim language, Your Honor.

5 Can you bring up Claim 9, Mr. Hartman? No, just --
6 just Slide 9. I'm sorry, Slide 9, not Claim 9.

7 Do you see in the -- in the paragraph that has the
8 phrase "interference fit," I'm going to start reading from
9 the fifth line from the bottom: The vertex of the bevel
10 being in contact with the receiving channel bottom -- I
11 don't think anybody's disputing what that means -- and
12 having an interference fit. So now we're talking about the
13 vertex of the bevel having an interference fit with the
14 receiving channel bottom when held in the eyeglass frame.

15 So -- so the -- and remember that the frame doesn't
16 necessarily go all the way around the lens. What the claim
17 says is that the interference fit is between the bevel
18 itself and the channel, not between the frame as a whole and
19 the lens that's placed into the opening in that frame.

20 THE COURT: Well, that seems like a pretty
21 important point to me.

22 MR. ISBESTER: As long as I've answered your --
23 your question, Your Honor.

24 THE COURT: No. I see -- I see what you're saying.

25 MR. ISBESTER: Now, the other problem, or the next

1 problem with the Plaintiff's definition is that it doesn't
2 find any support in the specification.

3 If you look at the -- the places where interference
4 fit is used in the specification, it's nowhere defined. It
5 simply refers to a fit of a bevel in a channel -- channel,
6 singular.

7 There's nowhere any discussion of the interference
8 fit being caused by the -- the lens being captured between
9 opposing sides of the frame. The interference fit referred
10 to is always the interference fit within the channel, which
11 is referred to in the patent, by the way, Your Honor, as the
12 retention structure.

13 And that's what you see in the figures, too. We've
14 already talked about Figure 2.

15 Now, Figure 2, you could imagine the -- the
16 addition of a frame at the bottom.

17 If we go to that, Mr. Hartman.

18 But I had to -- I had to create that drawing from
19 scratch. That's not in the patent. It'd be easy to -- for
20 a draftsman to add in that lower part and say that the
21 interference fit now is between the top and the bottom
22 portions of the frame. But that isn't shown in the patent.
23 Instead, what you see in the patent -- go to the next
24 slide -- Figure 3B, you've got one channel with the bevel
25 fitting up into it.

1 Figure 4, the exact same thing.

2 Figure 5, the exact same thing.

3 Nowhere in the patent does it describe a fit that's
4 created by the opposing sides of the lens being captured in
5 a frame.

6 Finally -- I'm sorry, I'm getting -- I'm getting
7 ahead of myself. I'm only up to three of four.

8 Next, the Plaintiff's definition contradicts the
9 file history. And here, we'd like to point to the
10 examiner's comments. And the examiner essentially said:
11 I've got this reference Chappell, and it teaches how to hold
12 a lens in an eyeglass frame, and it matches up. And he goes
13 through all the different ways in which it matches up with
14 the language of the claim, including interference fit.

15 And then he realizes, wait a second, it's not clear
16 what I mean by interference fit. And so he adds in the
17 parenthetical: The bevel fits into the triangular channel
18 in such a manner that the channel interferes with the motion
19 of the lens by frictional forces.

20 So that's what the examiner believed interference
21 fit to mean in 2012. This patent was prosecuted for another
22 two and a half years after that without anybody saying
23 anything to the contrary.

24 Now, there is a slide that Mr. Halan used.

25 May I switch to the video camera -- document

1 camera?

2 I think it was their Slide 11. And the point I'd
3 like to make about this quote is that it doesn't address
4 what is an interference fit. It addresses whether or not
5 Chappell has an interference fit.

6 The quote that you've been provided, by the way,
7 Your Honor, also conflates two different arguments. The
8 first paragraph -- or the start of the paragraph is an
9 argument to distinguish Claim 1 from Chappell. But then you
10 see where the term "Chappell" appears right here, that's
11 actually a separate paragraph addressing Claim 25.

12 When you read this passage in the -- in its
13 entirety in context, I think you would agree with me that it
14 nowhere is contradicting the examiner's understanding of
15 interference fit. It's simply disputing whether or not
16 Chappell has one.

17 Now, finally, Your Honor, I'd like to address a
18 point that you made in the -- thank you -- in your -- your
19 questions to Mr. Halan, and that is that the phrase -- the
20 definition of interference fit that's being offered by the
21 Plaintiff renders the phrase "in compression" superfluous.

22 Now, "in compression" is a term that was
23 specifically added in order to distinguish these claims over
24 the prior art and resulted in the allowance of the claims.
25 Without "in compression," these claims wouldn't have been

1 granted. So it's got to mean something important, and it's
2 got to mean something different from the interference fit.

3 But when you look at the Plaintiff's definition of
4 interference fit, it's impossible to see that.

5 If you look at Slide 31.

6 So here's my doctored-up Figure 2 again. And we
7 have an external dimension of the lens, per the Plaintiff's
8 proffered definition of interference fit. And that external
9 dimension exceeds the internal dimension between the frame
10 channel bottoms.

11 Now, this is nowhere described in the patent, and
12 it's nowhere depicted in the patent. So in an effort to try
13 and make this even more clear, I've doctored up another
14 figure from the patent. I've taken Figure 9D, which is a
15 complete lens, and then I've created a cross-section of a
16 metal frame that that lens is supposed to fit into.

17 And the lens has an external dimension that exceeds
18 the internal dimension -- that exceeds the internal
19 dimension of the metal frame.

20 Now, the only way you're going to get that lens
21 into that frame and keep it there is by compressing it. It
22 seems fairly unavoidable.

23 And if that results from the interpretation of
24 interference fit, then why did the examiner think that "in
25 compression" made a difference? Why did the Plaintiff think

1 that "in compression" made a difference to the scope of the
2 claim?

3 Now, I'd like to make one more point that we
4 haven't raised previously in our briefs and we haven't
5 identified in any of the slides.

6 But if we can go back actually to the previous
7 slide, Mr. Hartman.

8 You see that the -- the definition of interference
9 fit proffered by the Plaintiff includes the language
10 "internal dimension between the frame channel bottoms."
11 My -- my colleagues just told me -- and Mr. -- Mr. Halan had
12 referred to this, and we just did a search to see whether
13 the phrase "frame channel bottoms," "channel bottoms,"
14 plural "channels" appears anywhere in the patent. And it
15 doesn't.

16 Now, if the purpose of this invention was to create
17 an interference fit such that between two points on the
18 lens, two different channel bottoms, you had to squeeze the
19 lens into place, then surely that would have been described
20 somewhere in the patent. But nowhere in the patent is there
21 any such -- any such discussion.

22 I'd like to conclude on interference fit by just
23 noting, Your Honor, that the definition that Plaintiff --
24 excuse me, that -- that Hoya has offered now, and -- and my
25 apologies both to counsel and the Court that -- that we

1 offered this only in our opposition brief, but as Mr. Halan
2 notes, we realized the force of their argument. We had made
3 a mistake, and we sought to correct it. And what we have
4 done is simply adopt the examiner's understanding of
5 "interference fit" from the file history.

6 One of the purposes of his -- the advantages of the
7 intrinsic evidence is that it provides notice to the public
8 of what is meant by the terms being used in the claims in
9 particular. And certainly a member of the public reviewing
10 this file history would understand interference fit means
11 exactly what the examiner delineated there.

12 THE COURT: How do you respond to Plaintiff's
13 argument that what you're effectively asking the Court to do
14 is to recognize the patentee as his own lexicographer, and
15 yet it's the examiner that adopts this, not the -- not the
16 applicant or the patentee, and to enter into your own
17 lexicography, it's got to be your adoption, not just your
18 acquiescence in what the examiner may say? How do you
19 respond to that?

20 MR. ISBESTER: Well, I don't regard this as a
21 lexicography issue. And certainly we are -- we are not
22 suggesting that the examiner has expressly promulgated a
23 definition that is otherwise at odds with the record because
24 that's typically what happens in lexicography cases. The --
25 the claim term means something in light of the specification

1 and -- and so forth, but the applicant says, that's not
2 exactly the meaning I want in this -- in this claim, in --
3 in this -- for this -- the purpose of this patent.

4 That's not what happened here. Rather, the
5 examiner is looking at the record before him and saying:
6 I've -- I've come across this term.

7 What does the Plaintiff -- at that point,
8 Mr. Wiand, so the applicant, what does he understand
9 "interference fit" to mean? And the examiner is inferring
10 from the record what "interference fit" is intended to mean
11 in the context of this patent and these claims.

12 That's not really a lexicography situation. My --
13 my friend has suggested that what we're asserting is a
14 disavowal, an express disavowal. No, that's -- that's not
15 the situation here at all. We are not asking this Court to
16 find that the Plaintiff expressly disavowed, by virtue of
17 acquiescing in the examiner's interpretation.

18 Disavowal is a procedure or process by which the
19 applicant says things on the record that cause the scope of
20 the claim to be narrower. And what we are saying is, no,
21 the scope of the claim is out here, and it's Plaintiff's
22 extrinsic evidence that is narrowing the claim, making it
23 smaller.

24 So this is not a disavowal argument either. This
25 is simply reading a patent claim in light of the

1 specification and the file history of which it is a part and
2 inferring from that record what it is that the examiner, the
3 applicant, and a member of the public would understand
4 the -- the critical terms to mean.

5 THE COURT: All right. It seems like you're asking
6 to pack a lot into this inference that you believe the
7 public would see and others that would view the entirety of
8 the record would see and -- and be cognizant of. Inferences
9 are tricky things sometimes.

10 MR. ISBESTER: Yes, Your Honor. But our inference
11 has -- has two advantages.

12 First of all, it's clearly the inference the
13 examiner drew.

14 And, second -- if you go to the next slide -- it
15 entirely comports with the invention.

16 You know, our inference is consistent with this
17 being the invention. Their extrinsic evidence definition is
18 not.

19 THE COURT: Well, it seems like to me one of the
20 key issues here the Court's going to have to deal with, and
21 to a certain extent it seems to me that both sides are at
22 some level talking past each other, is the context of this
23 word "interference fit" and does it apply to a context that
24 involves a lens fitting within a frame, as Plaintiff
25 suggests, or does it lend itself to construction in a

1 context of merely the bevel relating to the channel. And
2 those -- those are different things. And you're both taking
3 different positions. And I've heard a lot why each of you
4 think you're right. I'm not so sure I've heard a lot why
5 you think the other one is wrong.

6 But the claim as a whole is going to have to be
7 read to -- by the Court in a way that identifies the proper
8 context for this disputed term, "interference fit," and it's
9 in all likelihood going to be one context or the other,
10 either the lens relating to the frame or the bevel relating
11 to the channel. But I don't see how it can be both.

12 MR. ISBESTER: I think you put your finger on
13 exactly the issue before the Court, and --

14 THE COURT: And I'm not sure that the Court won't
15 benefit more from a fuller reading of the entire claim
16 language than from the specific argument on what's in one
17 party's construction as opposed to the other.

18 MR. ISBESTER: I -- I could never disagree with
19 that comment, Your Honor.

20 What I would suggest, though, is that the
21 Plaintiff's construction is clearly dependent upon
22 "interference fit" describing a fit of the lens as a whole
23 within the eyeglass frame as a whole, and thereby
24 securing --

25 THE COURT: Well, let me ask you this. You make a

1 lot out of the fact that Plaintiff is presuming that the
2 frame completely -- and this is not precise -- but encircles
3 the lens. It's not a circle obviously, but I'll use that
4 word.

5 The glasses I'm wearing, that I've worn for 10
6 years, have a frame at the top, but they have what I would
7 in very imprecise terms call a piece of fishing line holding
8 the bottom half of the frame.

9 MR. ISBESTER: Your Honor, that's what Hoya calls
10 it, too.

11 THE COURT: And I haven't taken these apart, and
12 I'm not about to, but I suspect that there's a bevelled edge
13 in the top half of the lens as it interfaces with the frame,
14 and yet in the bottom half of the lens, there's a groove for
15 that fishing line to fit in. I'm not sure that -- I'm not
16 sure that my glasses, which don't have a frame that
17 completely encircles the lens, would cause me to construe
18 this term any differently than if I had a pair of glasses
19 where the frame did completely encircle the lens.

20 You seem to make a lot out of the fact that the
21 lens and the frame don't always cover 360 degrees around the
22 outer edge of the -- of the lens. And you seem to imply
23 that that's -- that's a scenario that the Plaintiff is
24 hanging their hat on, for lack of a better phrase.

25 How -- how important -- I mean, tell me why -- tell

1 me why this construction is impacted by the fact that not
2 all frames completely encircle all lenses. Why -- why does
3 that make as big of difference as -- as you believe it does
4 in this context as to the construction of this term?

5 MR. ISBESTER: I think I may be slightly -- I hope
6 this doesn't sound like a semantical difference, but my --
7 what I'd like to convey is that the Hoya definition would
8 apply equally to the bevel and channel in your eyeglasses,
9 Your Honor, as it would to a set of eyeglasses in which the
10 frame entirely encircles the lens. Nothing in the claim
11 language suggests that the claim is only applicable to
12 glasses in which the frame entirely encircles the lens.

13 And what I am -- what Hoya's trying to do is find
14 the claim construction that is most consistent with the
15 intrinsic evidence. Remember, the specification
16 specifically talks about frames that have only half the
17 frame, such as yours, but the construction that's now being
18 offered by the Plaintiff would exclude a set of glasses such
19 as yours.

20 This -- as I say, it's a topsy-turvy world that --
21 Your Honor, in which we're arguing that Claim 1 of the '360
22 patent covers more product than -- than the Plaintiff would
23 suggest.

24 But in the intellectual integrity exercise, I don't
25 see how you can read into Claim 1 a requirement that the

1 frame encompass the lens.

2 And to -- to finish that argument off, Your Honor,
3 at the top where this frame -- where you have a rim around
4 your lens, very likely you're right, there is a channel and
5 a bevel. And as long as -- as long as that bevel doesn't
6 pop out of the channel, you've got a fit.

7 Whereas, with the Plaintiff's definition, you've
8 only got a fit if the bevel is being forced up into the
9 channel by pressure from the fact that the lens is bigger
10 than the space into which it's being fit.

11 THE COURT: All right. How does that comport with
12 Figures 9D, E, and F in the '360 patent where you've clearly
13 got a bevel at the top of the lens and at the bottom of the
14 lens?

15 MR. ISBESTER: Absolutely, Your Honor.

16 And that's why -- you may recall that I used Figure
17 9D in Slide 32 of -- of our slide deck. I used Figure 9D as
18 the basis of the illustration.

19 But these are lenses that -- some of them would be
20 entirely encircled.

21 Now, I'm not sure that this applies to all of them.
22 There are -- sorry, I -- I didn't answer that very well.

23 These figures depict cross-sections from one side
24 to the other of the lens. But I think if you go up to 9A,
25 you've clearly got a bevel at the top and a bevel at the

1 bottom.

2 But at 9B, and I -- I assume the labels refer to
3 the figure above, Your Honor, so 9B, you've got a bevel at
4 the bottom -- whoops, yeah, there you go, yeah -- and you've
5 got a groove at the top. So it's not clear to me how that
6 lens is affixed on the side opposite the -- the bevel. That
7 groove may be something that the fishing line fits into, for
8 example.

9 And then on 9C, again, you've got a complete lens,
10 and you've clearly got a bevel at the bottom, but is the top
11 going to be used as a bevel? Is it going to fit into a
12 channel, or does that face get glued to a frame? I mean,
13 you know, there are many different ways that these lenses
14 might be mounted.

15 THE COURT: All right. Well, let's try to circle
16 back to the beginning, counsel. What else do you have with
17 regard to "interference fit" that you haven't told me so
18 far?

19 MR. ISBESTER: I can't imagine talking about
20 "interference fit" any further, Your Honor.

21 THE COURT: Okay. Well, let me -- let me thank you
22 for that argument, and let me inquire if Plaintiff has any
23 brief rebuttal.

24 If not, we'll move on. If you do, I'll hear it.

25 MR. HALAN: Yes, I do, Your Honor.

1 THE COURT: All right.

2 MR. HALAN: Using the rule of primacy, the -- the
3 last thing that was pointed out was these Figures 8A, B,
4 C -- well, I'm sorry, Figures 9A, 9B, 9C, 9D, 9E, 9F.
5 Opposing counsel was trying to argue that some of these
6 figures -- that's not a bevel shot on top, but, instead,
7 it's a channel. If you read the specification, all of those
8 things on top, whether it be 150, 154, 158, 162, 166,
9 they're all described as being a bevel, Your Honor. Those
10 are bevels meant to fit into the channel. So that was a
11 misleading comment. I just wanted to point that out.

12 And, basically, this whole thing boils down to --
13 this -- this is a very commonly understood term in the art.
14 And so here while it's not further defined in the spec, but
15 this is commonly understood by all of those in the art.
16 Again, all the evidence we've pointed to shows that's the
17 way -- and the treatises in the optical industry, prior art
18 patents, it's -- it's used that way. It's understood by
19 those in the art. There was no reason for the -- the
20 inventor to put in any additional definition. It's just the
21 way it's commonly understood.

22 And I wanted to point out that -- but, yeah, Hoya
23 points to nothing -- nothing to contradict those other than
24 they're relying on this examiner's statement, and who knows
25 what the examiner is really trying to say, but that was

1 never adopted by the patentee.

2 He pointed -- we talked about this -- this partial
3 frame. I just want to point out that -- hold on -- that is
4 part of a description from Column 4, Line 59, through Column
5 5, Line 14, of various embodiments.

6 And, first off, I want to point out that it's our
7 position that a frame would not have to completely encircle
8 a lens for there to be an interference fit. For example, if
9 we can imagine a -- a purely circular lens for -- it's
10 easier to understand. Let's say the frame only encircled
11 70 percent of it. If it was an interference fit, the lens
12 still wouldn't be able to fall off because it would -- it
13 would be encircled by slightly more than 50 percent. So
14 we're not saying the frame always has to be encircled, but
15 there does have to be an interference fit.

16 They're, again, arguing that this is simply
17 interference fit. But, again, this contact between the
18 vertex of a lens with the channel is claimed in other parts
19 of the claim. It's not part of the interference fit claim.
20 The interference fit is something in addition to this.
21 This -- their limitation alone is not interference fit. It
22 can't be.

23 They also made this argument about the -- the
24 length of our claim construction. Again, our real claim
25 construction is that part that we have highlighted in green,

1 Your Honor. And we -- we told you that this morning, we're
2 not seeking this lengthy claim construction.

3 And their -- their argument is that we are seeking
4 a lengthy claim construction in order to broaden our claim.
5 That was one of their arguments they made, a -- a lengthy
6 construction would actually try to narrow it. But we're
7 only relying on the one definition of interference fit
8 that's in green, and that's in our Slide 3.

9 THE COURT: I'm not so concerned about how many
10 words are there --

11 MR. HALAN: Okay.

12 THE COURT: -- as I am what the words are.

13 MR. HALAN: Thank you, Your Honor.

14 Go to Slide 18 if you can.

15 Yeah, they also made -- Claim 1 -- they pointed out
16 that Claim 1 recites the receiving channel defined by
17 opposed interior wall surfaces, and they're saying that
18 means it has to be triangular, as they're trying to fit into
19 this claim limitation -- or they're trying to fit a -- a
20 triangular limitation into their definition.

21 But, again, as shown here and explained, you can
22 have opposed wall surfaces with a flat surface between which
23 is shown in Figure 6 on the right. And this is specifically
24 one of the embodiments or the various embodiments defined in
25 the invention. So it doesn't have to be triangular. Again,

1 they're trying to add limitations that aren't part of a --
2 the definition of interference fit.

3 And -- and I guess I still don't really
4 understand their tolerance argument because our -- our --
5 we're not concerned with tolerances. We're -- we're
6 concerned about the interference fit that has -- which means
7 that the -- again, the dimension has to be larger than the
8 frame dimension.

9 And, again, they -- they said that our -- our
10 extrinsic evidence, we were cherry-picking, but if we were
11 cherry -- again, they've offered nothing, again, in
12 opposition to the -- all the extrinsic evidence, the --
13 which is a lot. I mean, it's all in the optics industry.
14 Again, they're relying on just some of the examiner's -- the
15 statement.

16 And in Phillips it -- Phillips itself said that if
17 there's a claim term at issue, and it's not a commonly
18 understood claim term by lay people, but it's understood in
19 the art by experts -- not by experts but by people of --
20 of -- in the industry, you can rely on extrinsic evidence to
21 understand what that claim term means.

22 THE COURT: What else, counsel?

23 MR. HALAN: I'm trying to look through my notes
24 here, Your Honor. I'm not sure if there's anything else or
25 not. May I have one second, Your Honor?

1 THE COURT: Take a moment.

2 MR. HALAN: I have one comment on one of the
3 slides. Oh, that's right.

4 So his Slide 22, also, he's -- he's -- he cites
5 quotes from different portions of the specification and says
6 that the specification nowhere defines interference fit as
7 we're asserting it. And, again, there is no -- we're not
8 saying there was a clear definition.

9 But if you -- he picked and chose language from
10 these portions of the spec. If you -- if you get beyond the
11 ellipses, what these are describing is -- in all these
12 instances is a fit in which the lens is secured within the
13 frame by an interference fit, which, again, an interference
14 fit in the nomenclature of the industry means that the --
15 one dimension exceeds the other dimension.

16 And that's all I have, Your Honor.

17 THE COURT: All right.

18 MR. HALAN: Okay.

19 THE COURT: Thank you, Mr. Halan.

20 Let's move on to "in compression," our next
21 disputed term. And --

22 MR. HALAN: Thank you.

23 THE COURT: -- we'll follow the same order. Let me
24 hear from the Plaintiff first.

25 MR. HALAN: Okay. So, again, Your Honor, this

1 slide shows -- on the left side is our -- the construction
2 we've been asserting. And, actually, we don't think this
3 term actually needs construction. We think the word
4 "compression" is easily understood. We only offered a
5 construction because they were asserting a construction was
6 needed.

7 So -- and they started off by -- again, the
8 original definition was pressed against something. Again,
9 after we pointed out in our brief this was -- couldn't be
10 true. Again, they understood the -- the error of their ways
11 and, again, tried to come up with an alternative deposition
12 (sic). And their definition now is being pressed together
13 but not necessarily into less space.

14 THE COURT: Well, that's the problem. Both of you
15 are saying the term needs no construction, its plain and
16 ordinary meaning should apply, but then you go on to recite
17 what you each believe the plain and ordinary meaning is, and
18 they don't match up.

19 MR. HALAN: That's right, Your Honor.

20 THE COURT: Particularly whether it can or can't --
21 or that -- should be and must necessarily be pressed into
22 less space or not necessarily placed into less space.

23 MR. HALAN: Right, Your Honor. Well, their
24 definition would actually include it being compressed into
25 less space. They -- they say it's not necessarily less

1 space.

2 THE COURT: Right.

3 MR. HALAN: But if you go to the next slide.

4 Again, this goes to what we talked about earlier,
5 Your Honor. Their argument -- basically, their only
6 argument against our construction is that if you press
7 something into less space, it must deform. And our patent
8 doesn't always require deformation, and we agree with that.

9 But as we pointed out earlier today, there's a
10 variety of reasons why compression does not necessarily
11 cause deformation. Again, the frame itself could bend or
12 deform. And it depends on the stiffness of materials and
13 the extent of the compression.

14 And, also, in the prosecution history itself, it
15 was stated that the lens could be compressed at the vertex
16 and make it form at the vertex, meaning that it doesn't
17 always have to form at the vertex. So by the prosecution
18 history itself, the patentee was saying that compression
19 doesn't always cause deformation.

20 Our position is that if you read, again, the
21 context -- you have to take the context within the claim,
22 and that's why we cite this case down here which is quoted
23 from Phillips, saying: Notably, the context in which a term
24 is used in the asserted claim can be highly instructive for
25 claim construction.

1 In this case, the context in which it's used is in
2 junction with interference fit. So if you go back to the
3 previous -- previous page, that's why we say it should
4 mean -- mean pressed into less space because that comports
5 with interference fit, and any other definition would not.

6 And, again, it would be fine, Your Honor, if we
7 just did not define it at all because we don't think it
8 needs to be defined. I think any jury can understand the
9 word "compression." It's not a -- and that's all I have,
10 Your Honor.

11 THE COURT: All right. Let me hear a response from
12 the Defendant.

13 MR. ISBESTER: Your Honor, may I first add one
14 sentence regarding interference fit, or is the book on that
15 closed?

16 THE COURT: One sentence.

17 MR. ISBESTER: If I may have the camera on.

18 The patent describes Figure 3B as a cross-sectional
19 view of the bevel in the interference fit with an eyeglass
20 frame. And that's -- this is 3B. This is an interference
21 fit, according to the patent.

22 THE COURT: All right. Let's move on.

23 MR. ISBESTER: Let me turn to compression then.

24 THE COURT: How do you compress something but not
25 necessarily in less space?

1 MR. ISBESTER: Well, Your Honor, this -- this big
2 building is clad in brick and stone, and I'm sure the bricks
3 at the bottom of the wall feel that they're under
4 compression. But let's hope that they're not taking up less
5 space. Lots of things are placed in compression, and their
6 value, their virtue is that they don't take up less space
7 when placed in compression.

8 Furthermore, the claim language itself requires
9 that the -- the bevel in some instances be compressed and
10 deformed. Well, any time you put something into less space,
11 it seems to me, you are inherently deforming it. It no
12 longer has the form it used to have. It now has a new form
13 that fits into less space.

14 THE COURT: What if you have a rubber ball and you
15 have it in a compression chamber and you raise the
16 compression such that all the surface of the rubber ball has
17 the same amount of force applied to it at the same time,
18 would not that ball just shrink in size but would remain in
19 the same exact shape?

20 MR. ISBESTER: It might have the same exact shape,
21 but the two-inch diameter ball is now only an inch and three
22 quarters in diameter. It has a different form, and the
23 question is not --

24 THE COURT: It's still a ball. It's a smaller
25 ball, but it's still a ball. There's no deformation there.

1 MR. ISBESTER: Your Honor, it hadn't occurred to me
2 that the word "form" is the word we should be -- we should
3 be construing here, or -- or deform.

4 My understanding of the word "form" is that it
5 includes changing something's shape. Something that is
6 merely shrunk or enlarged but has the same shape would still
7 be deformed. It would no longer have the same form, and,
8 therefore, compression is entirely -- if -- if you define
9 compression as being under pressure or pressed together and
10 having -- and taking less space, then you are defining "in
11 compression" to be the same as or at least a -- a flavor of
12 deformation. And since the claims distinguish between the
13 two, that would be impermissible.

14 I could go on, Your Honor, to the point that the
15 specification clearly distinguishes between deformation and
16 compression. And the file history is quite lengthy about
17 how it is important to avoid deformation even when there is
18 compression. But if one doesn't start from the same
19 starting point that shrinkage into a smaller space, a
20 smaller volume is a form of deformation, I'm not sure any of
21 that argument matters.

22 And -- and, frankly, I'm not sure that Mr. Halan
23 would -- would dispute my argument that both the
24 specification and the file history distinguish between being
25 in compression and deformation.

1 But it comes down to then what -- what we should
2 have done perhaps is provide your -- provide Your Honor with
3 guidance as to what we thought deformation meant.

4 THE COURT: Well, certainly there can be
5 compression that has with it deformation, but I'm not so
6 sure that there can't be compression that doesn't always
7 have deformation with it.

8 And you're saying -- you're saying by the two-inch
9 rubber ball being compressed with the exact same force on
10 all its surface such that it's now an inch and three
11 quarters, that that's deformed --

12 MR. ISBESTER: Yes.

13 THE COURT: -- in and of itself.

14 MR. ISBESTER: Yes, Your Honor.

15 THE COURT: And I'm not sure I agree with that.

16 MR. ISBESTER: Okay.

17 THE COURT: It's compressed, no doubt about it.
18 But I'm not sure it's compressed and deformed.

19 Now, if the -- if the pressure wasn't the same on
20 all parts of the surface, it certainly would be deformed,
21 but --

22 MR. ISBESTER: Well, let me go back, Your Honor, to
23 the -- and leave -- leave aside the question of -- of
24 deformation for the time being.

25 Let me go back to my building materials. Surely,

1 one of the advantages, one of the -- the virtues of concrete
2 and granite rock and brick is that even under compression,
3 sufficient to hold up bridges and buildings, they don't
4 shrink to take less volume. They -- they retain the -- the
5 volume that they were carved or poured to retain at the
6 outset.

7 And yet we would still call those "in compression."
8 We don't object to the pressed together aspect of
9 Plaintiff's definition. We only object to the notion that
10 there be some contraction in the volume necessarily in order
11 to effectuate compression.

12 And -- and the reason, Your Honor, of course, is
13 that Plaintiff is trying to find a basis to distinguish the
14 prior art from this claim. And the prior art will teach --
15 the prior art will teach a -- a lens that is pressed on the
16 top and the bottom by the frame, but the prior art perhaps
17 doesn't say and thereby the lens shrink to a smaller volume
18 or is compressed into a smaller volume. And this will be a
19 point of distinction that the Plaintiff argues between its
20 claim and the prior art.

21 So it -- it's not entirely an academic exercise.
22 I'd also like to point out that we aren't talking about a --
23 we're not talking about a rubber ball that's being
24 compressed on all sides.

25 If we can go to Slide 32.

1 THE COURT: No, we're certainly not, but we're also
2 talking about a lot of illustrations that don't have
3 anything to do with the patents-in-suit. I mean, obviously,
4 from a historical context, we're talking about eyeglasses
5 that used to have glass lenses that now have plastic --

6 MR. ISBESTER: Yes.

7 THE COURT: -- or polycarbonate lenses and pressure
8 on the glass causes it to break or shatter. Pressure on the
9 plastic causes it to compress.

10 Now, does that also mean it deforms? We get back
11 to the same issue.

12 MR. ISBESTER: Well, and -- and as best I can, I'm
13 going to try and respond to Your Honor's question without
14 using the word "deformation" or "deform."

15 When this lens shown on the screen now is forced
16 into the smaller gap between the top and the bottom of the
17 frame, is it simply going to retain its same shape and --
18 and get smaller? I don't think so.

19 What's going to happen is it's going to bow, to the
20 extent it gives, and the frame is going to stretch, to the
21 extent it gives.

22 But you would still call that lens "in
23 compression." There's certainly nothing in the patent that
24 suggests that when the lens is in the frame, by virtue of
25 the pressure exerted on the lens, it assumes a smaller

1 shape.

2 There's actually a discussion in the patent about
3 how the preliminarization process in a patent -- in a
4 plastic lens continues even after the lens has been
5 fabricated, and as a result, the lens shrinks. But that's
6 not related to the compression. That's related to the
7 chemical nature of the lens in question.

8 So we don't see any -- any basis in the
9 specification or the file history for this less space
10 component of compression. And if it is a plain and ordinary
11 meaning word, would you not say that those blocks at the
12 base of the pyramid are in compression, but they've been the
13 same size for 3,000 years.

14 The plain and ordinary meaning doesn't include
15 being shrunk in some uniform fashion so that the shape
16 doesn't change but the volume does.

17 THE COURT: Well, I'm not at all sure the blocks at
18 the base of the pyramids are identically the same shape as
19 they were 3,000 years ago. They may --

20 MR. ISBESTER: Fair point, Your Honor.

21 THE COURT: -- they may have -- whether we want to
22 call it compressed or deformed or whatever word we want to
23 use here as a verb, they may be nearly identical to the same
24 shape before or same size before, but I'm not sure there's
25 not some terribly small difference in size or shape.

1 The amount of compression/deformation is going to
2 obviously wide -- widely vary given the materials that are
3 at issue. The rubber ball may be at one extreme and a
4 diamond at the other.

5 MR. ISBESTER: Uh-huh.

6 THE COURT: But I'm not at all sure that -- I'm --
7 I'm trying to envision compression that over time does not
8 result in a change in the shape or the space of the item
9 that's compressed.

10 Can you -- can you tell me something that over
11 time, with constant pressure, maintains its exact same
12 dimension, shape, size? Can you give me an example of
13 something in the real world? I'm not sure I buy the fact
14 that the blocks at the pyramids -- they may be 99.15 times
15 past the decimal 9s the same shape they were 3,000 years
16 ago, but you can't put that much weight on them over that
17 length of time. I'm not sure there's any substance on this
18 planet that given enough pressure and enough time doesn't
19 change and become smaller in perpetuity. It may be a
20 terribly small difference in shape or size, but --

21 MR. ISBESTER: I think what you would see, Your
22 Honor, is that most things that are unable to support the
23 weight on them and remain -- so let me take a step back.

24 There's -- Your Honor raises the -- the potential
25 of something that has changed in volume by one billionth of

1 its size. And I simply am not equipped to deal with the
2 non-discernible changes. And with all due respect, Your
3 Honor, you have no record upon which you can address that
4 either.

5 For the purposes of this technology --

6 THE COURT: You're trying to persuade me that
7 you're right, and I'm trying to push back verbally --

8 MR. ISBESTER: Yes, okay.

9 THE COURT: -- to see if you can counter the
10 push-back and convince me further. We call that oral
11 advocacy.

12 MR. ISBESTER: Well, I appreciate the opportunity
13 to --

14 THE COURT: Sure.

15 MR. ISBESTER: -- to pursue it.

16 Most discernible reactions to pressure in the kinds
17 of materials we're talking about here, polycarbonate, very
18 carefully constructed polymer plastics, the metal of the
19 wire frame are going to be some kind of change in shape to
20 relieve the pressure. And that's why I -- I pulled up this
21 slide and talk about the bowing that's going to occur in the
22 lens and the stretching that's going to occur in the frame.

23 Those are the first, second, third, and fourth
24 order changes in shape.

25 THE COURT: Well, let me --

1 MR. ISBESTER: If there's shrinkage, if there's
2 reduction in volume, I think that's going to be so minute
3 that in the plain and ordinary meaning of the phrase
4 "compression," it would disappear.

5 THE COURT: Well, let me ask in this context, then.
6 Are you basically asking me to assume that when the larger
7 lens is forced into the smaller frame and fits within those
8 channels, that the stretching is all transferred to the
9 frame and the lens doesn't -- though it's in compression, it
10 doesn't change its shape and therefore it doesn't deform in
11 any way?

12 MR. ISBESTER: Absolutely not, Your Honor.

13 THE COURT: Okay.

14 MR. ISBESTER: And, in fact, what we think
15 happens -- if the lens is too big for the -- for the socket,
16 then you run into a real problem, because the lens tends to
17 bow. It tends to change shape. The curvatures are now
18 different from what the optician ordered. And you have a --
19 a situation in which the patient is unhappy because the lens
20 is no longer optically what is made to correct the vision.

21 THE COURT: Well, if the size of the lens is
22 significantly different than the size of the frame, perhaps
23 that bowing takes place. But if the differential between
24 the size of the lens and the size of the frame is much
25 smaller, then what takes place is this bevel compacts or

1 it -- it fits in your triangle. The -- the wood piece fills
2 out and deforms as it fits in more snugly. And so the lens
3 doesn't bow, but it's the bevel that -- that deforms and
4 gives you a stronger fit.

5 MR. ISBESTER: Exactly. And at that point, Your
6 Honor, the bevel is actually changing shape. We -- the --

7 THE COURT: Right. And so how do we do all this
8 and not necessarily change in shape, as you're asking me to
9 find?

10 MR. ISBESTER: Oh, no. No, I'm sorry, Your Honor,
11 we're not asking you to say the compression is without
12 changing shape.

13 THE COURT: Well, unless --

14 MR. ISBESTER: We're saying compression doesn't
15 necessarily require a change in volume in taking up less
16 space. We think -- we think compression results in things
17 changing shape all the time, especially when you're talking
18 about plastic lenses.

19 THE COURT: Okay.

20 MR. ISBESTER: It's only that you can't get that
21 same amount of plastic into any less volume, even though you
22 can warp it and bend it and twist it all sorts of ways.

23 THE COURT: That's a fair point. What else?

24 MR. ISBESTER: Your Honor, I don't think there's
25 any -- the file history or the specification would assist,

1 so I will dispense with arguments about that.

2 THE COURT: All right. Thank you.

3 Mr. Halan, do you have a brief rebuttal?

4 MR. HALAN: One second, Your Honor.

5 Your Honor, we have nothing else.

6 THE COURT: Okay.

7 MR. HALAN: Thank you, Your Honor.

8 THE COURT: All right, then. That will complete
9 argument on "in compression."

10 Counsel, do I understand that the parties agreed to
11 submit "defined by" and is -- "is from" to the Court on the
12 briefing, or do you want to present oral argument on these
13 terms?

14 MR. HALAN: We're going to let it ride on the
15 briefing, Your Honor, but if you have any questions, we're
16 ready and willing to answer them.

17 THE COURT: Defendant take the same position?

18 MR. ISBESTER: Yes, Your Honor.

19 THE COURT: All right. Well, that's not to say
20 that 10 minutes from now, I won't have questions, but as I
21 sit here right now, I don't.

22 So I'll consider those terms on the briefing that I
23 have complete in the file. And I'll consider the first two
24 terms on the argument that you've given me, along with that
25 briefing.

1 And unless you have something else for me, that
2 will complete argument on claim construction for this
3 afternoon.

4 I am going to take these matters under submission.
5 I'll try to get you guidance by way of a written claim
6 construction order as soon as possible.

7 I am going to direct that you mediate your disputes
8 within 30 days of the issuance of my claim construction
9 opinion.

10 Any questions from either side before we recess for
11 the day?

12 MR. HALAN: Your Honor, just one comment. If you
13 do have a question on those last two terms, if you want us
14 to submit a one-page something, we're willing to do so.

15 THE COURT: I understand. I know how to do that,
16 counsel.

17 MR. HALAN: Okay.

18 THE COURT: I won't be bashful.

19 MR. HALAN: All right. Thank you, Your Honor.

20 THE COURT: Anything from Defendant?

21 MR. ISBESTER: Your Honor, I -- the only question
22 that occurs to me is that I believe a date has been set for
23 the mediation.

24 THE COURT: And if it has, that's probably
25 something I need to know. Hopefully it's not tomorrow.

1 MR. ISBESTER: I believe it's May 2nd, Your Honor.

2 THE COURT: May 2nd. We're still in March. You'll
3 have an opinion long before May 2nd.

4 MR. ISBESTER: Thank you very much, Your Honor.

5 THE COURT: All right.

6 MR. HALAN: Thank you very much, Your Honor.

7 THE COURT: All right. Counsel, thank you for your
8 submissions. The Court stands in recess.

9 COURT SECURITY OFFICER: All rise.

10 (Recess.)

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

CERTIFICATION

I HEREBY CERTIFY that the foregoing is a true and correct transcript from the stenographic notes of the proceedings in the above-entitled matter to the best of my ability.

/S/ Shelly Holmes
SHELLY HOLMES, CSR-TCRR
OFFICIAL REPORTER
State of Texas No.: 7804
Expiration Date: 12/31/18

4/29/18
Date